APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/413,728	10/06/1999	THOMAS J. MARSAN	B-65583(0143	2353

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EXAMINER
BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

| **Office Action Summary** | **Application No.** 09/413,728 | **Applicant(s)** MARSAN ET AL. |
| | **Examiner** Igor Borissov | **Art Unit** 3629 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 January 2003</u> .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-7, 11-19 and 21-25 are rejected under 35 U.S.C. 102(b) as being

anticipated by Nair et al. (U. S. 5,479,530).

Nair et al. teach to an apparatus and method for capturing a signature applied to a

receipt, comprising:

As per claims 1,

- a substitute draft system operable to receive a retrieval request and to generate

a substitute draft in response to the retrieval request (Fig. 33; column 68, lines 9-28);

- a merchant interface coupled to the substitute draft system, the merchant

interface operable to generate a merchant request in response to the retrieval request

(column 67, lines 62-63);

- a mediation charge system coupled to the merchant interface, the mediation

charge system operable to receive a mediation charge and to generate a merchant

mediation charge if no response has been received to the merchant request (column 2,

lines 1-15; column 4, lines 18-28; column 5, line 48 through column 6, line 38; column

17, line 10 through column 19, line 24).

As per claim 2, the term "inhibit system" encompasses transaction processor (See Fig. 2, item 12).

As per claims 4 and 5,

- a merchant system operable to receive the merchant request and retrieve identification data in response (the host computer 40 of the transaction processor causes a receipt file stored in the storage to be searched) (column 68, lines 14-16).

As per claims 6 and 7,

- a bankcard system and bank system operable to generate the retrieval request and receive the substitute draft (bank card association generate a retrieval request and receive reproduced receipt) (column 18, lines 30-31; column 68, lines 9-28, 36-39). The bankcard association comprises banks that issue credit cards (column 17, lines 20-27).

As per claims 11 and 21,

- receiving the retrieval request (Fig. 33; column 68, lines 9-28);

- generating the substitute draft if it is determined that a retrieval request code is not in a set of retrieval requests codes that would prohibit the generation of the substitute draft (Fig. 33; column 2, lines 1-15; column 4, lines 18-28; column 5, line 48 through column 6, line 38; column 17, line 10 through column 19, line 24; column 46, lines 46-49; column 50, lines 28-35; column 68, lines 9-28);

- generating a merchant request in response to the retrieval request (column 67, lines 62-63).

As per claims 12 and 22,

- receiving the retrieval request (Fig. 33; column 68, lines 9-28),

- generating the substitute draft if it is determined that issuing bank data is not in a set of issuing bank data that would prohibit the generation of the substitute draft (column 2, lines 1-15; column 4, lines 18-28; column 5, line 48 through column 6, line 38; column 17, line 10 through column 19, line 24; column 46, lines 46-49; column 50, lines 28-35; column 68, lines 9-28);

- generating a merchant request in response to the retrieval request (column 67, lines 62-63).

As per claims 13 and 23,

- receiving the retrieval request (Fig. 33; column 68, lines 9-28);

- generating the substitute draft if it is determined that bank card agency data is not in a set of bank card agency data that would prohibit the generation of the substitute draft (column 2, lines 1-15; column 4, lines 18-28; column 5, line 48 through column 6, line 38; column 17, line 10 through column 19, line 24; column 46, lines 46-49; column 50, lines 28-35; column 68, lines 9-28);

- generating a merchant request in response to the retrieval request (column 67, lines 62-63).

As per claims 14 and 24,

- receiving the retrieval request (Fig. 33; column 68, lines 9-28);

- generating the substitute draft if it is determined that transaction amount data is not in a set of transaction amount data that would prohibit the generation of the substitute draft (column 2, lines 1-15; column 4, lines 18-28; column 5, line 48 through

column 6, line 38; column 17, line 10 through column 19, line 24; column 46, lines 46-49;

column 50, lines 28-35; column 68, lines 9-28);

   - generating a merchant request in response to the retrieval request (column 67,

lines 62-63).

   As per claims 15 and 25,

   - receiving the retrieval request (Fig. 33; column 68, lines 9-28);

   - generating the substitute draft if it is determined that card user data is not in a

set of card user data that would prohibit the generation of the substitute draft (column 2,

lines 1-15; column 4, lines 18-28; column 5, line 48 through column 6, line 38; column

17, line 10 through column 19, line 24; column 46, lines 46-49; column 50, lines 28-35;

column 68, lines 9-28);

   - generating a merchant request in response to the retrieval request (column 67,

lines 62-63).

   As per claim 16,

   - a bank system operable to generate the retrieval request in response to user-

entered data (bank generate a retrieval request) (column 18, lines 30-3 l; column 68,

lines 9-28);

   - a bankcard system comprising banks operable to receive the retrieval request

from the banks (column 17, lines 20-27; column 18, lines 30-31; column 68, lines 9-28);

   - a transaction system coupled to the bankcard system operable to receive the

retrieval request and to generate a substitute draft and a merchant request, the

transaction system is operable to assess a mediation charge against the merchant

system if the merchant system has not generated sales draft data in response to the

merchant request (column 2, lines 1-15; column 4, lines 18-28; column 5, line 48

through column 6, line 38; column 17, line 10 through column 19, line 24; column 46,

lines 46-49; column 50, lines 28-35; column 67, lines 62-63; column 68, lines 9-28);

    - a merchant system coupled to the merchant interface and operable to receive

the merchant request and generate sales draft data in response (column 67, lines 62-

63).

    As per claims 17-19, the transaction system (processor) is operable to receive

bank system data, card user data and transaction amount data with the retrieval request

and to generate a substitute draft in response (column 67, lines 62-67; column 68, lines

4-6, 11-14).

Claim Rejections - 35 USC § 103

    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

    Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Nair et al.

    As per claims 26 and 27, Nair et al. teach all the limitations of claims 26 and 27,

except that the signature data associated with the retrieval request is not used to

generate the substitute draft.

It would have been an obvious matter of design choice at the time the invention

was made to modify Nair et al. to include that the signature data associated with the

retrieval request is not used to generate the substitute draft because it well known in the

art to use various record data units for computerized transaction record systems. See,

for example, Johnson et al. (US 5,813,009) showing a digital camera as an input data

source (Abstract; column 8, lines 46-59).

Response to Arguments

Applicant's arguments filed on 01/27/03 have been fully considered but they are

not persuasive.

In response to applicant's argument that Nair et al. fail to disclose a "merchant

system " and "mediation charge system", Examiner points out that these features are

shown in Nair et a. (See column 2, lines 1-15; column 4, lines 18-28; column 5, line 48

through column 6, line 38; column 17, line 10 through column 19, line 24; column 67,

lines 62-63, and discussion above).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D. C. 20231

or faxed to:

(703) 305-7687   [Official communications; including After Final communications labeled "Box AF"]

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